

## **REMARKS**

Reconsideration and allowance of the subject patent application are respectfully requested.

Claims 1, 2, 6-9, 11-13, 15-17, 20-27 and 29-32<sup>1</sup> were rejected under 35 U.S.C. Section 103(a) as allegedly being based on a proposed combination of Oki (U.S. Patent No. 5,859,969) and Nakagawa et al. (U.S. Patent No. 5,835,911). Claim 33 was rejected under 35 U.S.C. Section 103(a) as allegedly being made “obvious” by the proposed Oki-Nakagawa et al. combination, in further view of the admitted prior art described in the subject patent application.

The independent claims recite, among other things, providing a program list which prioritizes programs that are likely to be operable in an operating environment of a user system. This feature finds support, for example, in the subject patent application at pages 38-41 of the subject patent application.

The office action acknowledges that Oki does not “explicitly show” the prioritized list of programs as claimed. See pages 5 and 13 of the office action. Nonetheless, the office action contends that one of ordinary skill would prioritize the program list provided by host computer of Oki in such a way that most likely programs of interest are to the user are listed first.

Applicant traverses this contention.

The specification of the subject patent application describes by way of example, and without limitation, systems and methods which (i) refer to operating environment information, e.g., reflecting the combination of an image forming apparatus and optional equipment, (ii) specify programs available to be used in a system including the image forming apparatus and optional equipment, (c) display a program list, e.g., on an operation display section of the image forming apparatus, and (d) add desired programs to the image forming apparatus. The program list prioritizes programs that are likely to be operable in the operating environment of the user system after confirming the components of the user system and thus it can be easy for a user to select programs from the list.

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<sup>1</sup> The office action does not identify claim 28 in the list of rejected claims on page 4 of the office action and there is no express reference to this claim in the body of the rejection on pages 4-14 of the office action.

In contrast, systems like Oki require that the user input certain keywords in order for the program list to be generated. Thus, the user is required to have some knowledge (or know some technical terms) in order to input the keywords.

As mentioned above, the office action contends that it would have been obvious to prioritize Oki's list such that the "most likely programs of interest to the user are listed first." However, the claims recite prioritizing programs that are likely to be operable in an operating environment of a user system. This is different than prioritizing based on user interest. Consequently, even assuming for the sake of argument that prioritizing based on user interest as alleged by the office action would have been obvious, modifying Oki in this manner would not result in the claimed subject matter, which involves prioritizing programs based on likely operability in a user system.

The independent claims have been amended to recite that the prioritized program list is *based on the operating environment transmitted from the user system* to even more clearly distinguish the claims from the applied references. According to Oki (see steps S1-19, especially col. 6, line 44 to col. 7, line 50), a user A selects a first keyword and a second keyword to ask host computer 21 for a list of software corresponding to both the first and second keywords. This is not the same as, nor is it suggestive of, a prioritized list based on an operating environment transmitted from the user system. Neither Oki nor Nakagawa discloses or suggests a prioritized list as claimed.

As further described by way of example, and without limitation, in the subject patent application at pages 35-39, when a user wants to expand functions of an image forming apparatus 31, the user is not likely to know, for example, what exact function can be expanded. In this illustrative example, the image forming apparatus 31 only needs to request that the server 32 transmit a list of programs which can be supplied by the server 32, and there is no need for the user to select any specific program-related information before the server 32 transmits a program list which prioritizes programs that are likely to be operable in an operating environment of the user system. Therefore, customer service can be improved.

In contrast, according to Oki, the user must know what software he intends to update or install, and the software list corresponds to keyword inputs by the user. As noted above, in Oki (see steps S1-19, especially col. 6, line 44 to col. 7, line 50), a user A selects a first keyword and

a second keyword to ask host computer 21 for a list of software corresponding to both the first and second keywords.

To even further emphasize the differences between the claims and the applied references, the independent claims have been amended to variously recite transmitting a request to the server without selecting any specific program-related information, the request requesting the server to provide a list of programs. Neither Oki nor Nakagawa discloses or suggest this feature. In particular, as noted above, Oki requires a user to input keywords in order to generate a list. Consequently, the proposed combination of Oki and Nakagawa would not have resulted in the subject matter of the pending claims.

Pages 2-3 of the 5/12/2009 office action provide some responses to the arguments about the prioritized program list which are presented in the 2/26/2009 amendment.

In the paragraph that bridges pages 2 and 3, the office action references the description in Oki about the comparison of the circumstance information with the target software. However, this comparison is conducted after the user selects a particular software application (e.g., Tetris) as described beginning at col. 7, line 51. Applicant respectfully submits that this has nothing to do with providing a prioritized program list as claimed.

The first full paragraph on page 3 of the office action reproduces the text from Oki at col. 2, lines 27-45. This text again relates to the comparison of the circumstance information to the target software, which, as noted above, takes place after the target software is selected from a list. Thus, this comparison does not relate to how a prioritized program list is generated.

NOMURA et al.  
Appl. No. 09/892,747  
Response to Office Action dated May 12, 2009

The pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

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